



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,265	07/27/2001	Ramani S. Wonderling	IM-5	7797

26949 7590 03/05/2003

HESKA CORPORATION
INTELLECTUAL PROPERTY DEPT.
1613 PROSPECT PARKWAY
FORT COLLINS, CO 80525

EXAMINER

MARTINELL, JAMES

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/05/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,265

Applicant(s)

WONDERLING ET AL.

Examiner

James Martinell

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1631

In the Requirement for Restriction mailed November 25, 2002, claim 21 was inadvertently omitted from treatment. The error is regretted. Claim 21 is grouped by itself as Group V, being drawn to a method for identifying a compound that may have immunoregulatory activity by performing binding assays with feline IL-8, feline caspase-1, or IL-12 single chain protein *in vitro* and classified in class 435, subclass 7.1. For completeness, the Groups of claims as filed are outlined below and the reasons why Group V is independent and distinct from each of Groups I-IV are given herein below.

- I. Claims 1-14, 16, and 20, drawn to polynucleotides, recombinant viruses, host cells, and methods for making proteins, classified in class 536, subclass 23.5 and class 435, subclasses 320.1, 69.1, and 325.
- II. Claim 15, drawn to methods of treatment using nucleic acids, classified in class 514, subclass 44.
- III. Claim 17, drawn to polypeptides, classified in class 530, subclasses 350 and 351.
- IV. Claim 18, drawn to antibodies, classified in class 530, subclass 387.1.
- V. Claim 21, drawn to methods for identifying compounds by binding to polypeptides, classified in class 435, subclass 7.1.

The polynucleotides, recombinant viruses, and host cells of Group I are not needed to practice the methods of Group V. The methods of Groups I and II may be practiced independently of the methods of Group V. The polypeptides of Group III have uses other than the assays of Group V. For example, the polypeptides of Group III may be used in the treatment of animals. The antibodies of Group IV are not needed to practice the methods of Group V.

Claims 15 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Applicant's election with traverse of the requirement for restriction in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Group II recites the subject matter of Group I and that the methods of Group II requires the use of the products of Group I. Applicants further refer to

Art Unit: 1631

MPEP § 802.01 in arguing that the two groups are not independent. This is not found persuasive because the methods of immune response regulation of Group II are distinct from the products and methods of Group I. For example, the methods of Group II may require various doses and the adjustment of other parameters that are not required for proper search and examination of the invention of Group I. The last paragraph of MPEP § 802.01 clearly states that even dependent (related) inventions may be properly divided if the inventions are distinct.

Applicants also argue that all of the sequences mentioned in Group I ought to be searched and examined in one application because the sequences are functionally related and share sequence identity (about 93% at the nucleotide level and 86-89% at the amino acid level). This argument is most unpersuasive in view of the number of embodiments embraced in the claims. For example, claim 1(a)(i)(3) recites "a nucleic acid molecule comprising at least 44 contiguous nucleotides identical in sequence to at least 44 contiguous nucleotides of a nucleic acid sequence selected from the group consisting of SEQ ID NO: 32 and SEQ ID NO: 35" and claim 1(a)(ii)(3) recites "a nucleic acid molecule comprising at least 47 contiguous nucleotides identical in sequence to at least 47 contiguous nucleotides of a nucleic acid sequence selected from the group consisting of SEQ ID NO: 46 and SEQ ID NO: 49." Since the claims recite fragments of the mentioned SEQ ID NOs, separate searches are needed for each SEQ ID NO mentioned. To search more than one SEQ ID NO would be a significant search burden on the USPTO.

The disclosure is objected to because of the following informalities.

The instant application does not comply fully with the Sequence Rules (*i.e.* 37 CFR §§ 1.8.21-1.825) in that amino acid sequences greater than 4 amino acids long are disclosed at page 105, lines 12 and 13 without the required identifying SEQ ID NOs (37 CFR § 1.821(d)). For any response to this Office action to be considered to be a complete response, correction of this matter is required.

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1631

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.


Claims 1-14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite.

- (a) Claims 1-14 are vague and indefinite in that they recite more sequences than the elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1631